

REMARKS

Applicant amends claims 1, 19, 21, 22, 34, 39, 44, 46, and 47. These amendments are supported, e.g., by FIG. 2 and associated text. Applicant cancels claims 14, 15, 24-26, 37, 38, 40-43, and 45 without prejudice or disclaimer. Claims 1, 3-11, 13, 16-19, 21-23, 34, 39, 40, 44, 46 and 47 are pending. Applicant requests the Examiner reconsider the rejections in light of the arguments presented below.

Claim Objections

The Examiner requested that claims 25, 26, 37, 38, 43, and 45 be canceled because of a Restriction Requirement issued on 25 September 2009. Applicant notes that the rejection mailed on 18 November 2009 contained rejections for all claims, including claims 25, 26, 37, 38, 43, and 45. Consequently, Applicant believed the Restriction Requirement was officially withdrawn.

However, Applicant has canceled claims 25, 26, 37, 38, 43, and 45 in accordance with the Examiner's requirement in the outstanding Office Action.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1, 3-11, 13-15, 17, 19, 21-24, 34, 39-42, 44, 46, and 47 under 35 U.S.C. §102(a) as being anticipated by Herrero (U.S. Patent Publication no. 2005/0009520) in view of 3GPP TS 32.335 v2.0.0 (hereinafter, 3GPP). Applicant respectfully disagrees.

Amended independent claim 1 recites the following:

A method, comprising:

receiving at a first network element in a communications network a first message from a user equipment;

transmitting the first message from the first network element to a serving network element;

detecting at the first network element that the serving network element is out of service;

determining at the first network element a type of the first message, wherein determining the type of the first message comprises evaluating content of a predefined information element in the first message;

in response to detecting at the first network element that the serving network element is out of service and to determining that the type of the first message is a re-registration request, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service; and

subsequent to sending the error message to the user equipment, receiving a second message having an initial registration type from the user equipment .

Regarding this rationale, it is said in our claim: “transmitting the first message from the first network element to a serving network element” (see independent claims 1, 19, 41, and 44). The Examiner seems to map the “serving network element” of claims 1, 19, 41, and 44 incorrectly to I-CSCF in Herrero (although in Herrero the REGISTER request seems to be sent also to S-CSCF). Again, in the rejections to these claims, the Examiner refers to paragraphs [0136] and [0144]. These paragraphs concern responses to SIP INVITE messages rather than to SIP REGISTER messages. Claim 1 specifically recites that the type of the first message is a “re-registration” request, and not an “invite” message.

In section [0069] of Herrero, it is merely discussed what is defined in different 3GPP documents. And again, the second message in our case (see amended claim 1) is initial registration message (or request), not re-registration as the Applicant respectfully submits the Examiner incorrectly tries to map. The Examiner acknowledges that Herrero does not teach “determining at the first network element a type of the first message, wherein determining the type of the first message comprises evaluating content of a predefined information element in the first message; in dependence on the determined type of the first message, sending from

the first network element to the user equipment an error message including an indication that the serving network element is out of service”.

Regarding these features, the Examiner says that these correspond to a situation described in the 3GPP document, where a SIP request is sent and then an SIP response is returned - and in case of a failure, an error message is sent.

We disagree that this corresponds to the alleged situation in the 3GPP document for at least the following reasons:

In certain of our claims (e.g., claims 1, 19, 43, and 44) the error message is sent based on two different conditions which both need to be met:

- the serving network element is out of service; and
- the content of the received message (received from the user equipment).

See, e.g., claim 1: “detecting at the first network element that the serving network element is out of service “; and “in response to detecting at the first network element that the serving network element is out of service and to determining that the type of the first message is a re-registration request, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service”.

3GPP does not explicitly seem to disclose what is meant by “in case of failure”. This may mean that the serving network element is out of order, but it does not pose any additional requirements, i.e. in addition to that also examine a predetermined portion of the message and only after that decide whether an error message is to be sent, as recited in independent claims 1, 19, and 44.

Thus clearly Herrero combined with 3GPP do not teach 1) detecting that serving network element is out of service and 2) examining a predetermined portion of the request and based upon those two checks send an error message.

Thus, claim 1 is patentable over the alleged combination of Herrero and 3GPP. Because claim 1 is patentable, claims 19, 41, and 44 are patentable over the alleged combination of Herrero and 3GPP. Amended claim 34 also recites “in dependence on the determined type of the first message received from the user equipment, send an error message to the user equipment including an indication that the serving network element is out of service” and is also patentable for at least the reasons given above.

With respect to independent claims 21, 39, and 47, these claims recite the subject matter of “sending a first message having a type of a re-registration request”, “receiving an error message from a network element in a communications network in response to the first message, the error message indicating that a serving network element for the apparatus is out of service”, “in response to the error message, to send a further message having an initial registration type to the network element” or similar. As described above, neither Herrero nor 3GPP nor their combination discloses receiving an error message from a first network element in a communications network in response to a first message having **a type of a re-registration request**, where the error message indicates that a serving network element for the apparatus is out of service, and in response to the error message, sending a message **having an initial registration type**. Consequently, independent claims 21, 39, and 47 are patentable over the combination of Herrero and 3GPP.

Because independent claims 1, 19, 21, and 39 are patentable, their dependent claims 3-11, 13-18, 46, 22-26, and 40 are also patentable for at least the reasons given above.

Conclusion

Based on the foregoing arguments, it should be apparent that the remaining claims are thus allowable over the reference(s) cited by the Examiner, and the Examiner is respectfully requested to reconsider and remove the rejections. The Examiner is invited to call the undersigned attorney for any issues.